

### **REMARKS**

Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1, 3-18, 21, 22, and 25 are pending in the present application. Claims 1, 10, 18, and 22 are the independent claims.

Claims 1, 18, and 22 have been amended. No new matter has been added.

Claims 1, 8, 9, 18, 20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11-306570 A (Shimokawa et al.) in view of U.S. Patent No. 5,666,843 (Ezawa et al.). Claims 3-7, 21, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimokawa et al. in view of Ezawa et al., and further in view of U.S. Patent No. 6,091,553 (Song et al.). Claims 10, 11, and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0193854 (Lee et al.) in view of U.S. Patent No. 6,163,416 (Uekusa et al.). Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Uekusa et al., and further in view of U.S. Patent No. 5,446,721 (Sekimoto et al.). All rejections are respectfully traversed.

Independent claim 1 recites, inter alia, that a first damping member is inserted in a center portion of focusing coils and surrounded thereby.

Independent claim 18 recites, inter alia, inserting at least one damping member in at least one location ... the at least one location being a center of the focusing coils of an optical pickup so that the at least one damping member is surrounded by the focusing oils.

Independent claim 22 recites, inter alia, ... inserting at least one damping member in a center of focusing coils so that the at least one damping member is surrounded by the focusing coils.

However, Applicants respectfully submit that none of the asserted citations disclose at least the aforementioned features of independent claims 1, 18, and 22. Thus, without conceding the propriety of the asserted combinations, it is respectfully submitted that the asserted combinations are likewise deficient for at least the reasons set forth below, even in view of the knowledge of those of ordinary skill in the art.

Regarding the rejection of independent claims 1, 18, and 22, the Office Action acknowledges that the primary citation to Shinokawa et al. does not disclose at least one damping member. (Office Action, page 3).

The secondary citation to Ezawa et al. discusses an arrangement including viscoelastic members 3a and 3b respectively between focusing coils 4a and 4b and a lens holder 2. (Ezawa et al.; FIG. 6). The Office Action contends that the area between the focusing coils is a center portion and the viscoelastic members are disposed in the center portion. (Office Action, page 2). However, assuming arguendo that this characterization is correct, the viscoelastic members are not inserted in a center portion of focusing coils and surrounded thereby. Indeed, as FIG. 5 of Ezawa et al. illustrates, the alleged damping members (viscoelastic members 3a and 3b) are not surrounded by the focusing coils. Thus, the combination of Shinokawa et al. and Ezawa et al. cannot reasonably be said to disclose at least the aforementioned features of independent claims 1, 18, and 22.

It is submitted that the tertiary citations to Song et al. or Sekimoto et al. do not add anything that would remedy the aforementioned deficiencies.

Turning to the rejection of independent claim 10, the Office bears the initial burden of factually supporting any prima facie conclusion of obviousness. If a prima facie case is not presented, an applicant is under no obligation to submit evidence of nonobviousness. (The Manual of Patent Examining Procedure, § 2142). Applicants respectfully submit that such is the case at present.

It is respectfully submitted that the Office has not made out a prima facie case of the obviousness of independent claim 10 at least because the Office's explanation of why one of ordinary skill in the art would have been motivated to modify Lee et al. in view of Uekusa et al. is deficient. In particular, the Office Action expressly asserts that one of ordinary skill in the art would have been motivated to combine Lee et al. and Uekusa et al. because of various alleged teachings of U.S. Patent No. 5,446,721 to Sekimoto et al. (Office Action, page 8). Applicants respectfully submit that such a rationale is fatal to this rejection at least because Sekimoto et al. does not suggest the asserted combination of Lee et al. and Uekusa et al. for at least the reasons set forth at page 8 of the last Amendment. And, because prima facie case has not been presented, Applicants are under no obligation to submit further evidence of nonobviousness.

Accordingly, favorable reconsideration and withdrawal of the rejections of independent claims 1, 10, 18, and 22 are respectfully requested.

Also, it is respectfully submitted that the next action rejecting independent claim 10 based on a combination of Lee et al. and Uekusa et al. cannot properly be made final since such

a rejection would be a new ground of rejection that is neither necessitated by an amendment of the claims nor based on information submitted in an information disclosure statement.

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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